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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/517,400

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EXAMINER

PATEL, ASHOKKUMAR B

ART UNIT

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2154

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/517,400	Applicant(s) ASAMI, AKIKO	
	Examiner ASHOK B. PATEL	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 1-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/31/05,02/28/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-36 are subject to examination. Claims 1-18 are cancelled.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 29 and 36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Referring to claims 29 and 36,

These claims are claim to a software, per se, and therefore fail to fall into category of invention. Therefore proper correction is required.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 19, 27, 28, 29, 30, 35 and 36 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 13, 17, 18, 19, 20, 21, 22, 23 and 24 of copending Application No. 10/515, 976. Although the conflicting claims are not identical, they are not patentably distinct from each other because these claims claim the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless-

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 19-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Shiloh (US 2001/0037316 A1).

Referring to claim 19,

Shiloh teaches an information management device for managing content provision to an information processing device connected to said information management device via a network (ABSTRACT), comprising:

storage means for storing image data for displaying an image of a character and character feature information indicative of said character (Fig.5, element 68 is a character and “user profile” of Fig. 4 is virtual personality data is character feature.);

character selection means for selecting said character from among characters of which image data is stored in said storage means based on user feature information indicative of a user of said information processing device and said character feature information (para. [0034], [0056]);

image data transmission means for transmitting, to said information processing device, said image data of said character selected by said character selection means (para. [0085], [0086]); and

content transmission means for transmitting content associated with said character selected by said character selection means to said information processing device (para. [0022], [0023]).

Referring to claim 20,

Shiloh teaches the information management device according to claim 19, further comprising:

content selection means for selecting said content associated with said character selected by said character selection means on the basis of said user feature information (para. [0085], [0087]).

Referring to claim 21,

Shiloh teaches the information management device according to claim 19, further comprising:

evaluation information acquisition means for acquiring evaluation information indicative of an evaluation of said content used on said information processing device (para. [0073]);

wherein said character selection means updates said user feature information in accordance with said evaluation information acquired by said evaluation information acquisition means, thereby selecting said character on the basis of said updated user feature information and said character feature information (para. [0073]).

Referring to claim 22,

Shiloh teaches the information management device according to claim 19, further comprising:

charging means for charging, to said information processing device, a fee of said content transmitted by said content transmission means (para. [0027], [0034]).

Referring to claim 23,

Shiloh teaches the information management device according to claim 19, further comprising:

identification information reception means for receiving, from said information processing device, identification information held in an object read by said information processing device; wherein said character selection means selects a character which is represented by an image in accordance with an external shape of said object on the basis of said identification information received by said identification information reception means (para. [0022], [0023], [0085]).

Referring to claim 24,

Shiloh teaches the information management device according to claim 19, further comprising:

transmission management means for managing the transmission of said content to said information processing device by transmitting information about access to another information processing device to which said content is provided and identification information of said content to said information processing device (para. [0086]).

Referring to claim 25,

Shiloh teaches the information management device according to claim 19, further comprising:

user feature information extraction means for extracting said user feature information based on an input by said user of said information processing device, said input being transmitted from said information processing device (para. [0085]).

Referring to claim 26,

Shiloh teaches the information management device according to claim 19, further comprising:

input information acquisition means for acquiring input information of said user including said user feature information indicative of a feature of a user for selecting said character or said content (para. [0085]).

Referring to claim 27,

Claim 27 is a claim to an information management method for an information management device of claim 19. Therefore claim 27 is rejected for the reasons set forth for claim 19.

Referring to claim 28,

Claim 28 is a claim to a recording medium recording a computer-readable program for an information management device of claim 19. Therefore claim 18 is rejected for the reasons set forth for claim 19.

Referring to claim 29,

Claim 29 is a claim to program for making a computer for controlling an information management device of claim 19. Therefore claim 29 is rejected for the reasons set forth for claim 19.

Referring to claim 30,

Shiloh teaches the information processing device connected, via a network, to an information management device for managing content provision (Abstract), comprising:

image data reception means for receiving image data of a predetermined character transmitted from said information management device (Fig.5, element 68 is a character image data.);

display means for displaying said predetermined character based on said image data received by said image data reception means (Fig.5, element 68);

content acquisition means for acquiring content associated with said predetermined character displayed by said display means (Fig.5, element 68, para. [0034], [0056], [0085]); and

output means for outputting said content acquired by said content acquisition means (Fig.5, element 68, para. [0034], [0056], [0085]).

Referring to claim 31,

Shiloh teaches the information processing device according to claim 30, further comprising: evaluation information transmission means for accepting input of an evaluation associated with said content outputted by said output means and transmitting evaluation information indicative of said evaluation to said information management device (para.[0073]).

Referring to claim 32,

Shiloh teaches the information processing device according to claim 30, further comprising: read means for reading identification information from an object in which said identification information is held; and identification information transmission means for transmitting said identification information read by said read means to said information management device (Fig.5, element 68, para. [0034], [0056], [0080], [0081], [0085]).

wherein said image data reception means receives image data for displaying an image corresponding to an external shape of said object selected by said information management device on the basis of said identification information (Fig.5, element 68, para. [0034], [0056], [0080], [0081], [0085]).

Referring to claim 33,

Shiloh teaches the information processing device according to claim 30, wherein, based on information about access to another information processing device to which said content is provided and identification information of said content, said information being transmitted from said information management device, said content acquisition means acquires said content from said another information processing device (para. [0034], [0056], [0080], [0081], [0085]).

Referring to claim 34,

Claim 34 is a claim to an information management method for an information management device of claim 30. Therefore claim 34 is rejected for the reasons set forth for claim 30.

Referring to claim 35,

Claim 35 is a claim to a recording medium recording a computer-readable program for an information management device of claim 30. Therefore claim 35 is rejected for the reasons set forth for claim 30.

Referring to claim 36,

Claim 36 is a claim to program for making a computer for controlling an information management device of claim 30. Therefore claim 36 is rejected for the reasons set forth for claim 30.

Conclusion

Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashok B. Patel whose telephone number is (571) 272-3972. The examiner can normally be reached on 6:30 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan A. Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Ashok B. Patel/

Primary Examiner, Art Unit 2154